

In th claims:

Please cancel claims 1-5.

REMARKS

Claims 1-10 are pending in the application.

The Obviousness-type Double Patenting Rejection of Claims 1-5 Over Claims 1-5 of US Patent 5,799,982.

The cancellation of claims 1-5 renders this rejection moot.

The Obviousness-type Double Patenting Rejection of Claims 6-10 Over Claims 1-5 of US Patent 5,799,982 In View of Olson.

Applicant's attorney respectfully traverses this rejection for the reasons explained below. Applicant's attorney can show that the obviousness-type double patenting rejection violates the principles of 35 U.S.C. §121, which states in part:

A patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

Both the present application and the '982 patent cite parent priority to application serial no. 08/573,446. Applicant's attorney encloses a response to a restriction requirement in the '446 application that was filed on May 1, 1997. This response elected the Group II claims, which were drawn to a labeling system. The Group I claims were drawn to an adhesive sticker, and were the subject matter of US 5,799,982. The method claims (Group III) are the subject of the present application. Thus, the present application is "an application filed as a result of such a requirement" within the meaning of §121. Therefore, Applicants' attorney respectfully traverses the rejection and requests it to be

withdrawn because the '982 patent issued as a result of the same three way restriction requirement that necessitated the present application.

The Examiner cites *In re Schneller*, 214 USPQ 210 (CCPA 1968) in support of the obviousness-type double patenting rejection. The rule of *Schneller* is that, even where there has been no restriction requirement between related applications as is technically required to invoke §121, double patenting rejections still cannot be sustained where the inventions being claimed in a first patent and a later application are "independent and distinct" within the meaning of 35 U.S.C. §121. See *Schneller* at pp. 214-215. The holding of *Schneller* was that the applicant had not met its burden of showing that the inventions were independent and distinct.

Subsequent decisions in the Court of Appeals for the Federal Circuit have explained that obviousness-type double patenting rejections must be based solely upon patentable distinctions *in the claims of the respective patent*, and this determination must be made without using the text of the patent disclosures or other patent disclosures as prior art.

A more recent decision, *General Foods v. Studiengesellschaft Kohle*, 23 USPQ2d 1839 (Fed. Cir. 1992), has reconsidered the issue of patentable distinctness in obviousness-type double patenting considerations. Page 1845 of the *General Foods* decision states that no terminal disclaimer is required where the two inventions are *patentably distinct*. On page 1845 of the opinion, the court concluded that it was error to use a portion of claim 1 for its disclosure as though it were prior art while ignoring the concept of patentability of total invention that was defined and protected by the entire claim. The claims cannot be read for what they merely disclose while ignoring the concept of the entire invention that the claims define. Page 1846 of *General Foods* follows numerous cases standing for the proposition that the patent disclosure cannot be used as prior art in obviousness-type double patenting rejections. The *Aldrich* decision in 158 USPQ 311, 314 (CCPA 1968), is used to provide the quotation:

double patenting rejections cannot be based on section 103, . . . or on the disclosures of the patents whose claims are relied on to demonstrate double patenting or on the 'disclosures' of their claims . . . [P]atent claims are looked to only to see what *has been patented*, the subject matter which *has been*

protected, not for something one may find to be disclosed by reading them.

It is evident from the *General Foods* decision that the correct inquiry in *Schneller* was whether the claimed combination ABCX was separately patentable as a different invention over the claimed combination ABCY. *Schneller* is distinguished from the present situation because there is a restriction requirement in the parent '446 application that proves the inventions are patentably distinct.

It is also apparent from the *General Foods* decision, as quoted above, that it is improper to combine references in a §103 manner, as is presently done with the Olson patent, when formulating an obviousness-type double patenting rejection. The correct inquiry is whether the respective inventions being claimed are patentably distinct, not whether the claims and/or disclosure of the issued '982 patent may be combined with other references.

Applicants' attorney respectfully solicits a Notice of Allowance in this application. Applicants' attorney believes that no additional fees are due, but the Commissioner is authorized to charge any additionally required fees to deposit account 04-1697. Applicants' attorney urges Examiner Fridie to telephone if a conversation could expedite prosecution.

Respectfully submitted,

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